

REMARKS

In the Office Action, the Examiner rejected claims 1-51. By this paper, the Applicants added new claims 52-55, cancelled claim 14, and amended claims 1, 11-13, 15, 20, 21, 31, 36, 44, and 50 for clarification of certain features to expedite allowance of the present application. Upon entry of these amendments, claims 1-13 and 15-55 remain pending in the present application and are believed to be in condition for allowance. In view of the foregoing amendments and the following remarks, the Applicants respectfully request reconsideration and allowance of all pending claims.

The Applicants also stress that the present and previous amendments are not believed to narrow the scope of the present claims, but rather these amendments broaden the scope or increase potential damages for infringement of the present claims. However, if these amendments narrow elements of the claims in any way, then Applicants emphasize that it is not for reasons relating to patentability. For example, the Applicants note that certain amendments clarify the elements of the claim, yet these amendments are neither necessary nor required by the Examiner to overcome rejections under 35 U.S.C. §§ 101, 102, 103, 112, or other relevant laws relating to patentability. However, if any amendments do, *arguendo*, narrow elements of the claims for reasons relating to patentability, then the Applicants do not believe these amendments preclude application of the doctrine of equivalents in accordance with the Supreme Court's recent decision in *Festo*. *See Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 62 U.S.P.Q. 2d 1705, 1714 (Sup. Ct. 2002); *see also Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 68 U.S.P.Q. 2d 1321, 1327-28 (Fed. Cir. 2003). The Applicants, as those of skill in the art, are neither aware of, nor do Applicants foresee, any equivalents to any such claim elements, which are *arguendo* narrowed for reasons relating to patentability. *See Festo*, 62 U.S.P.Q. 2d at 1714. Moreover, if any equivalents exist, *arguendo*, at the time of these amendments, then the Applicants emphasize that the reasons for amending the particular claim element are only tangentially related to the equivalents. *See id.* Finally,

if equivalents are, *arguendo*, foreseeable or directly related to the reasons for these amendments, then the Applicants respectfully assert that shortcomings of the language, and other reasons, prevented the Applicants from adequately describing the particular equivalent. *See Festo*, 68 U.S.P.Q. 2d at 1327-28. For these reasons, the Applicants do not surrender any potentially existing or future equivalents relating to elements of the present claims.

Objection to the Specification

In the Office Action, the Examiner objected to the disclosure because of the following informalities: page 3, line 21 “with” should be “within”; and page 8, line 10, “with” should be “within.” In view of these clerical errors, the Applicants amended the specification as set forth above. In view of this amendment, the Applicants respectfully request the Examiner withdraw the objection to the specification.

Claim Rejections under 35 U.S.C. § 101

In the Office Action, the Examiner rejected claims 31-35 under U.S.C. § 101 stating:

These claims, directed to a program per se is non-statutory matter since the machine readable medium has not been specified. Therefore the medium may not be “tangible” medium, such as a floppy disk. Office Action, page 2.

While Applicants do not necessarily agree with the Examiner’s rejection, Applicants have amended independent claim 31 to recite a “tangible medium.” Accordingly, Applicants note that the Examiner’s rejection is now moot and respectfully request that the Examiner allow independent claim 31 and the claims that depend therefrom.

Claim Rejections under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1-10, 15-19, 21, 27-28, 31-34, 36, 42-43 under U.S.C. § 102(b) as anticipated by Mochizuki et al. (U.S. Patent No. 4,875,633, hereinafter “Mochizuki”). Applicants respectfully traverse this rejection.

Legal Precedent

Anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under section 102, a single reference must teach each and every limitation of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Accordingly, the Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. The prior art reference also must show the *identical* invention “*in as complete detail as contained in the ... claim*” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

Claim Features Omitted from Cited Reference

Independent claims 1, 15, and 21

Turning to the claims, amended claim 1 recites, *inter alia*, “controlling the motorized drive *to adjust tension* of the second reeled media”; amended claim 15 recites, *inter alia*, “means for transitioning from speed based control *to tension based control* of the second reeled media to facilitate transitioning and splicing between the first and second reeled media”; and amended claim 21 recites, *inter alia*, “a transition drive controller adapted to transition a motorized media drive from speed control *to tension control* of the second reeled media.” (Emphasis added.)

However, Mochizuki fails to teach these features of claims 1, 15, and 21. In fact, as the Examiner stated, “the Mochizuki et al[.] reference does not include any tension control specifics.” Office Action, page 3. Thus, *a fortiori*, Mochizuki fails to teach controlling or adjusting tension. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claims 1, 15, and 21 and the claims depending therefrom.

Independent claims 31, 36, and 44

Amended claim 31 recites, *inter alia*, “wherein the machine readable code is adapted to control speed of a motor driving the second reeled media at least prior to splicing and adapted to *control torque* of the motor driving the second reeled media at least subsequent to splicing”; amended claim 36 recites, *inter alia*, “a media drive disposed adjacent the second reel structure and adapted to drive the replacement media and to *apply a force opposing rotation of the replacement media for a transition from the unwinding media to the replacement media*”; and amended claim 44 recites, *inter alia*, “providing a transition drive controller adapted to control a media transition drive to accelerate the replacement media to a surface speed of the unwinding media and to *generate a torque that opposes unwinding of the replacement media upon or after being spliced with the unwinding media*.” (Emphasis added.)

Mochizuki fails to teach these features of claims 31, 36, and 44. Specifically, Mochizuki teaches a paper splicing device 1 that absolutely fails to control or adjust the torque of the motor 21 driving the succeeding paper roll 3a subsequent to splicing. In addition, Mochizuki fails to teach controlling the motor 21 to oppose the rotation of the succeeding paper roll 3a. In fact, the drive system of Mochizuki includes drive belts 12 and 13 for paper rolls 3a and 3b, which drive belts 12 and 13 are driven at identical speeds. See Mochizuki, Fig. 1; col. 4, line 66–col. 5, line 2. In view of these identical speeds, the drive system of Mochizuki is absolutely incapable of opposing rotation of the succeeding paper

roll 3a. *See id.* Based on these missing features, Applicants respectfully request that the Examiner withdraw the rejection of claims 31, 36, and 44 and the claims depending therefrom.

Claim Rejections under 35 U.S.C. § 103(a)

The Examiner rejected claims 11-14, 20, 22-26, 29, 30, 35, 37-41, and 44-51 under 35 U.S.C. § 103(a) as obvious over Mochizuki in view of Suzuki et al. (U.S. Patent No. 6,073,876, hereinafter “Suzuki”).

Legal Precedent

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). The Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). Moreover, a statement that the proposed modification would have been “well within the ordinary skill of the art” based on individual knowledge of the claimed elements cannot be relied upon to establish a *prima facie* case of obviousness without some *objective*

reason to combine the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d. 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d. 1161 (Fed. Cir. 1999).

Claim Features Omitted from Cited References

In the Office Action, the Examiner specifically stated:

While the Mochizuki et al reference does not include any tension control specifics, it is old and well known in the art to provide tension control to a running web, especially after a splicing operation, and specifically it would have been obvious to control tension in the device of Mochizuki et al. in view of the teaching Suzuki et al. [sic]. Suzuki et al. directly relates [sic] to tension control of a web during and after a splice operation and includes all of the claimed features set forth in the application relating to tension control, specifically that the new roll is driven to coincide with the rotational speed of the expiring web and after splicing is braked in a tension controlled manner, see col. 9, paragraph beginning on line 53.

Essentially, the Examiner has taken Official Notice of facts outside of the record that the Examiner apparently believes are capable of demonstration as being "well-known" in the art. Although the Examiner cited Suzuki, the Applicants stress that Suzuki is missing certain claim features, which are not believed to be well known in the art in context of the present claims. Therefore, in accordance with M.P.E.P. § 2144.03, the Applicants hereby seasonably traverse and challenge the Examiner's use of Official Notice. Specifically, the Applicants respectfully request that the Examiner produce evidence in support of the Examiner's position as soon as practicable during prosecution and that the Examiner add a reference to the rejection in the next Official Action. If the Examiner finds such a reference and applies it in combination with the presently cited references, the Applicants further request that the Examiner specifically identify the portion of the newly cited reference that discloses the allegedly "well known" elements of the instant claim, as discussed above, or withdraw the rejection.

In addition, Suzuki fails to obviate the aforementioned deficiencies in Mochizuki. Specifically, with respect to claim 1 and the claims that depend therefrom, Suzuki does not teach “controlling the motorized drive to adjust tension of the second reeled media.” Instead, Suzuki teaches brakes 6, 7 and 8 to control the feeding speed of the paper rolls 3, 4, and 5. Suzuki, col. 4, ll. 52-55. With respect to claim 21 and the claims that depend therefrom, Suzuki fails to disclose “a transition drive controller adapted to transition a motorized media drive from speed control to tension control of the second reeled media.” In contrast, Suzuki does not even disclose a transition drive controller. Similarly, Suzuki does not teach the machine readable code adapted to control the torque of a motor driving the second reeled media as recited in claim 31. Suzuki also fails to teach or suggest the media drive adapted to apply a force opposing the rotation of the replacement media recited in claim 36 and the transition drive controller adapted to generate a torque that opposes the unwinding of the replacement media recited in claim 44. In contrast to claims 36 and 44, Suzuki teaches brakes 6, 7, and 8 (not drives) that oppose the rotation of the paper rolls 3, 4, and 5. Thus, neither Mochizuki nor Suzuki, taken alone or in combination, teach or suggest *all* the features of independent claims 1, 20, 21, 31, 36, and 44 and their dependent claims.

For these reasons, the Applicants respectfully requests withdrawal of the rejections under 35 U.S.C. § 103.

New Claims

As noted above, the Applicants added new claims 52-55. After careful review of the cited references, the Applicants stress that these claims recite features missing from the cited references taken alone or in combination. In view of these missing features, the Applicants respectfully request allowance of these claims.

Conclusion

The Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Authorization for Extensions of Time and Payment of Fees

In accordance with 37 C.F.R. § 1.136, Applicants hereby provide a general authorization to treat this and any future reply requiring an extension of time as incorporating a request thereof. The Commissioner is authorized to charge the requisite fee of \$150.00 for additional claims, and any additional fees which may be required, to Deposit Account No. 01-0857; Order No. 03AB059/YOD (ALBR:0134).

Respectfully submitted,



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